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June 10, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Xue et al.
Application No. 10/007,973
Filed November 13, 2001


Art Unit 1745
Examiner J. Maples

Pre-Graphitic Carbonaceous Insertion Compounds and Use as Anodes in
Rechargeable Batteries

(Attorney Docket No. P22,561-A USA)

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Sarah Klosek

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Reply to Requirement for Restriction Dated May 10, 2005

Sir:

In response to the Examiner's Action mailed May 10, 2005, applicants traverse hereby the Examiner's Requirement for Restriction set forth therein and request respectfully reconsideration and withdrawal of the Requirement.

The Examiner has required restriction between the following groups of claims:

Group I. - Claims 45 - 57, which are directed to a process for preparing a carbonaceous host, classified in class 423, subclass 414; and

Group II. - Claims 61 – 69 and 71-88, which are directed to an electrochemical device/battery, classified in class 429, subclass 231.8.

The basis for the Examiner's Requirement for Restriction is that he considers the claim groups to be distinct in that the product of claim Group II can be made by a process other than that of claim Group I.

It is submitted respectfully that the Examiner's Requirement is deficient on its face because 35 U.S.C. § 121 requires that the involved inventions be not only distinct, but also independent. Clearly, the inventions defined in the claims of Groups I and II are not independent in that the Group II claims define a product prepared by the process defined in the Group I claims.

The Examiner has recognized apparently that the claim groups do not define independent inventions because he has not characterized them as being independent. Moreover, the Examiner has not even attempted in his Action to explain why he considers the claims to be directed to independent inventions. Consequently, the Examiner has issued a requirement that is deficient on its face because he has not explained why the two claim groups are considered to define independent subject matter. Accordingly, the Requirement should be withdrawn.

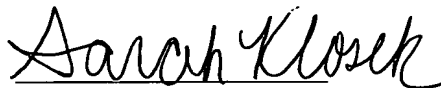
It is submitted further that the Examiner's Requirement should be withdrawn because it is believed that a proper search of the subject matter of either the Group I claims or the Group II claims requires that a search be conducted for the subject matter of both groups of claims. This is because the subject matter of the claims is so interrelated. For example, the

Group I claims are directed to a method for preparing a carbonaceous host, which includes the carbonaceous insertion compound used in the electrochemical device of the Group II claims.

As requested by the Examiner, applicants elect provisionally with traverse to prosecute the Group I process claims 45-57. Applicants request respectfully that, upon indication of allowable subject matter with regard to the elected claims, the withdrawn device claims which include all the recitations of the process claims be rejoined for examination of patentability (M.P.E.P. Section 821.04).

It is believed that the claims in this application are in condition for allowance. A favorable action on the merits is respectfully requested. If there are any additional charges in connection with this amendment, the Examiner is authorized to charge Applicant's Deposit Account No. 19-5425 therefor.

Respectfully submitted,

A handwritten signature in black ink, reading "Sarah Klosek". The signature is fluid and cursive, with the first name "Sarah" and last name "Klosek" clearly distinguishable.

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